

## REMARKS

Claims 1 and 8 have been amended to recite: (1) each screw opening as being in a lateral direction in relation to the axis of the stem as in original claim 3; and (2) the interior surface of the outer wall of the head being spaced from the end portion of the stem when the head is placed over the end portion of the stem as clearly shown in Figures 11 and 12.

Claim 3 has been canceled in view of the amendment to claim 1.

Claims 11-26 have been canceled. Applicant reserves the right to file divisional application(s) directed to the subject matter of these canceled claims.

### 35 U.S.C. 102

Claims 1-3, 5-6 and 8-9 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,887,277 to Rauscher *et al.* ("Rauscher"). Independent claims 1 and 8 now recite the interior surface of the outer wall of the head being spaced from the end portion of the stem when the head is placed over the end portion of the stem. This allows the head to move freely with respect to the stem for proper alignment of the stem when the head is placed over the stem during implantation of the prosthetic system. Looking at Figure 11 of Rauscher, the interior surface of the head 33 is not spaced from the stem 9. Therefore, the head 33 of Rauscher cannot move freely with respect to the stem 9 during implantation. Accordingly, it is submitted that amended independent claims 1 and 8 (and claims 2, 4-7 and 9-10 that depend thereon) recite a feature not shown or suggested in Rauscher that provides advantages over Rauscher.

Claims 1, 2 and 5-10 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,428,577 to Evans *et al.* ("Evans"). Evans was not applied to original claim 3, which is now part of amended independent claims 1 and 8. Therefore, it is submitted that amended

independent claims 1 and 8 (and claims 2, 4-7 and 9-10 that depend thereon) recite a feature not shown or suggested in Evans.

Claims 1, 2, 5, 6, 8 and 9 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0120339 to Callaway *et al.* ("Callaway"). Callaway was not applied to original claim 3, which is now part of amended independent claims 1 and 8. Therefore, it is submitted that amended independent claims 1 and 8 (and claims 2, 4-7 and 9-10 that depend thereon) recite a feature not shown or suggested in Callaway.

#### 35 U.S.C. 103(a) Rejections

Claim 4 was rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,887,277 to Rauscher *et al.* As detailed above, amended independent claims 1 and 8 (and claims 2, 4-7 and 9-10 that depend thereon) recite a feature not shown or suggested in Rauscher that provides advantages over Rauscher. Therefore, this rejection of claim 4 is overcome.

Claims 1-6 and 8-9 were rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,361,563 to Terrill-Grisoni *et al.* ("Terrill-Grisoni"). The Office Action first concedes that "Terrill-Grisoni does not disclose the connector however, to be a screw, but a spring instead." The Office Action then concludes that "it would have been obvious to one having ordinary skill in the art at the time the invention was made, to use screws instead of springs, as such would merely constitute a substitution of functional equivalents (providing the same function of securing)". The Applicant respectfully disagrees. In this regard, it is submitted that a *prima facie* case of obvious cannot be established using Terrill-Grisoni. Specifically, M.P.E.P. § 2143.01 V. states that:

"If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)."

Looking at Terrill-Grisoni, column 10, lines 21-28 state that "Once sizing has been determined to be acceptable, the modular sizer head insertion tool 3.13 is reattached to the modular head 2.13, and the modular sizer body holding tool 3.15 is placed back into the neck portion 2.55, or keyway, of the stem sizer. The modular head 2.13 is unlocked from the modular body 2.14 (sic) by rotating the modular head 2.13 a quarter turn, or 90°, relative to the modular body 2.15 again, and the modular head 2.13 is removed from the joint space." (Underlining added.) Thus, if one were to use a screw to secure modular head 2.13 to modular body 2.15 of Terrill-Grisoni as suggested in the Office Action, the Terrill-Grisoni device would be unsatisfactory for its intended purpose, that is, the modular head 2.13 would not be free to rotate and be removed from modular body 2.15.

In view of the M.P.E.P. § 2143.01 V. guidance that a proposed modification cannot render a prior art invention being modified unsatisfactory for its intended purpose, it respectfully submitted that Terrill-Grisoni cannot be modified to arrive at the invention of amended independent claims 1 and 8. Accordingly, amended independent claims 1 and 8 (and claims 2, 4-7 and 9-10 that depend thereon) are believed to be patentable over Terrill-Grisoni.

#### Conclusion

It is believed that the entire application is in condition for allowance. Other than the extension fee, no additional fees are believed to be needed for entering this amendment. If any additional fees are needed, please charge them to deposit account 17-0055.

Dated: January 9, 2007

Respectfully submitted,  
By: Richard T. Roche  
Richard T. Roche  
Registration No. 38,599  
Quarles and Brady LLP  
411 East Wisconsin Ave.  
Milwaukee, WI 53202  
(414) 277-5805

5975641